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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Fabio Vignoli

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EXAMINER

WASSUM, LUKE S

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/528,681	Applicant(s) VIGNOLI ET AL.	
	Examiner Luke S. Wassum	Art Unit 2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The Applicants' amendment, filed 29 July 2008, has been received, entered into the record, and considered.

2. As a result of the amendment, claim 12 has been amended. Claims 1-12 remain pending in the application.

Priority

3. The Applicants' claim to foreign priority as a 371 application of PCT/IB/03/03660, filed 18 August 2003, which depends for priority upon European Patent Application EP-02078955.8, filed 24 September 2002, is acknowledged.

The priority documents have been received and entered into the record.

Claim Objections

4. Claim 12 is objected to under 37 CFR 1.75(c) as being in improper form because the claim fails the Infringement Test. See MPEP § 608.01(n)III.

Under the terms of the Infringement Test, the test for a proper dependent claim is that the dependent claim "shall not conceivably be infringed by anything which would not also infringe the basic claim."

Dependent claim 12 fails this test, because it is conceivable that a recording media, such as a CD-ROM, containing a computer program, could infringe dependent claim 12 ("A computer-readable medium containing a computer program product...") without infringing base claim 11 ("A method of operating with different types of media content..."). Until the computer program is installed in a computer and executed, the claimed computer-readable medium containing a computer program product does not perform the method of claim 11, and so a CD-ROM containing a computer program could infringe dependent claim 12 without infringing base claim 11.

This being the case, claim 12 fails the Infringement Test, and is thus an improper dependent claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1, 3, 8 and 10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Regarding claims 1, 3, 8 and 10, these claims are for a system. However, all of the elements claimed [identifying means, associating means, selection means and rating means] could be reasonably interpreted in light of the disclosure by an ordinary artisan as being software alone, and thus is directed to functional descriptive material [software *per se*], which is non-statutory. For instance, the Applicants' specification at page 8, line 31 through page 9, line 5, discloses that the claimed means *may be* implemented by using a microprocessor coupled to RAM and ROM storing a program. However, drawing Figure 2 suggests a software implementation of the claims 'means'. See *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1759.

In order for software claims to be statutory, they must be claimed in combination with an appropriate medium and/or hardware to establish a statutory category of invention and enable any functionality to be realized. Compare *In re Lowry* (CAFC) 32 USPQ2d 1031 at 1031,1035 (claim to a data structure stored on a computer readable medium that increases computer efficiency held statutory) and *In re Warmerdam* (CAFC)

31 USPQ2d 1754 at 1759 (claim to computer having a specific data structure stored in memory held a statutory product-by-process claim) with *In re Warmerdam* (CAFC) 31 USPQ2d 1754 at 1760 (claim to a data structure per se held non-statutory).

8. In light of the Applicants' amendment to claim 12, the pending rejection of this claim under 35 U.S.C. § 101 is withdrawn.

9. Further regarding claim 12, this claim cites a computer-readable medium. In light of the language in the Applicants' specification on page 9, lines 26-28, apparently distinguishing the computer-readable medium from a transmission medium, and in the absence of any modifying disclosure of this limitation in the specification, the examiner interprets the term 'computer-readable medium' as excluding printed paper, transmission media, signals, or any form of energy, such that the claim clearly falls within a statutory class of invention as required under the terms of 35 U.S.C. § 101.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-3 and 7-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Billmaier** (U.S. Patent 6,630,963).

12. Regarding claim 1, **Billmaier** teaches a system for operating with different types of media content as claimed, the system being arranged to enable a user to use a first content of a first type (see disclosure that a user watches television content, col. 1, lines 15-36 et seq.), characterized in that the system comprises:

a) identifying means for identifying that the user concurrently uses a second content of a second type (see disclosure that a user selects a secondary audio program to replace the primary audio program associated with a television transmission, col. 9, lines 1-10 et seq.), said second content being unrelated with the first content (see disclosure that the secondary audio content is transmitted via the Internet, col. 2, lines 44-51 et seq.; the

examiner notes that Applicants' specification discloses that the term 'unrelated' should be interpreted as meaning that the system has no data indicating the relation between the contents, page 3, lines 21-24; although the television and secondary audio content might both be broadcasting the same event, they are independently produced and broadcast, and there is no reference in either data stream to the other, which means that for the purposes of the claimed invention, the video and audio broadcasts are unrelated; the fact that the buffering period of the video stream must be manually calibrated in order to match the audio stream provides further evidence that the streams are unrelated); and

- b) associating means for associating said second content with the first content (see disclosure that the user selects a desired secondary audio program to replace the primary audio program associated with the television transmission, col. 9, lines 1-10 et seq.).

13. Regarding claim 11, **Billmaier** teaches a method of operating with different types of media content, the method comprising the step of identifying a user's usage of a first content of a first type (see disclosure that a user watches television content, col. 1, lines

15-36 et seq.), characterized in that the method further comprises a step of identifying that the user concurrently uses a second content of a second type (see disclosure that a user selects a secondary audio program to replace the primary audio program associated with a television transmission, col. 9, lines 1-10 et seq.), said second content being unrelated with the first content (see disclosure that the secondary audio content is transmitted via the Internet, col. 2, lines 44-51 et seq.; the examiner notes that Applicants' specification discloses that the term 'unrelated' should be interpreted as meaning that the system has no data indicating the relation between the contents, page 3, lines 21-24; although the television and secondary audio content might both be broadcasting the same event, they are independently produced and broadcast, and there is no reference in either data stream to the other, which means that for the purposes of the claimed invention, the video and audio broadcasts are unrelated; the fact that the buffering period of the video stream must be manually calibrated in order to match the audio stream provides further evidence that the streams are unrelated), and a step of associating said second content with the first content (see disclosure that the user selects a desired secondary audio program to replace the primary audio program associated with the television transmission, col. 9, lines 1-10 et seq.).

14. Regarding claim 2, **Billmaier** additionally teaches a system further comprising storage means arranged to store meta-data comprising information pertaining to said associated first and second content (see disclosure that the storage device may store, *inter alia*, electronic programming guide (EPG) data, col. 5, lines 10-15 et seq.; see also disclosure of synchronization data associated with media content, col. 7, lines 10-43).

15. Regarding claim 3, **Billmaier** additionally teaches a system further comprising selection means arranged to select the content (see disclosure that the user selects a desired secondary audio program to replace the primary audio program associated with the television transmission, col. 9, lines 1-10 et seq.).

16. Regarding claim 7, **Billmaier** additionally teaches a system wherein said selection means are further arranged to user-operably modify said meta-data (see disclosure that the buffering period for a given media content is user-adjustable, col. 7, lines 26-27).

17. Regarding claim 8, **Billmaier** additionally teaches a system wherein said identifying means is arranged to identify a user's usage of a third content of a second or other type, said usage being concurrent to said user's usage of the first content, and said

third content being unrelated with the first content, and wherein said associating means is arranged to associate said third and first content (see disclosure of the association of additional content or a variety of different types, col. 9, lines 29-50), the system further comprising rating means arranged to rate said association of the first content with the second content and/or with the third content (see disclosure of the explicit selection of secondary audio content, thus rating the association positively, col. 8, lines 26-30).

18. Regarding claim 9, **Billmaier** additionally teaches a system comprising a plurality of devices, each device including output means arranged to output at least one type of the media content, and/or input means arranged to obtain at least one type of the media content (see disclosure of a system comprising a plurality of set top boxes, television, personal computer, advanced television set, or another type of client terminal, col. 3, lines 18-25, as well as a head-end centrally-located facility where television programs are received from local cable television, satellite downlink or other sources and routing video streams and other data to and from the various set top box devices serviced thereby, col. 3, lines 48-67).

19. Regarding claim 10, **Billmaier** additionally teaches a system wherein said first and second content correspond to video and audio content (see disclosure that a

secondary audio program is selected to replace the primary audio program associated with the television [video] transmission, col. 9, lines 1-5).

20. Regarding claim 12, **Billmaier** additionally teaches a computer-readable medium containing a computer program product enabling a programmable device, when executing said computer program product, to perform the method as claimed in claim 11 (see disclosure of the use of software, col. 4, lines 52-57; see also col. 6, lines 35-47).

21. Claims 1-4 and 6-12 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bahn** (U.S. Patent 7,162,728).

22. Regarding claim 1, **Bahn** teaches a system for operating with different types of media content as claimed, the system being arranged to enable a user to use a first content of a first type (see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.), characterized in that the system comprises:

- a) identifying means for identifying that the user concurrently uses a second content of a second type (see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.), said second content being unrelated with the first content (see disclosure that, for example, the user can elect to listen to jazz style music while viewing content on a shopping channel accessed over interactive television, col. 2, lines 33-35); and
- b) associating means for associating said second content with the first content (see disclosure that once the user's selections have been made, the selections can be stored as user preferences in an audio library collection and then applied during subsequent viewing of the shopping channel, col. 6, lines 40-43 et seq.).

23. Regarding claim 11, **Bahn** teaches a method of operating with different types of media content, the method comprising the step of identifying a user's usage of a first content of a first type (see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.), characterized in that the method further comprises a step of identifying that the user concurrently uses a second

content of a second type (see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.), said second content being unrelated with the first content (see disclosure that, for example, the user can elect to listen to jazz style music while viewing content on a shopping channel accessed over interactive television, col. 2, lines 33-35), and a step of associating said second content with the first content (see disclosure that once the user's selections have been made, the selections can be stored as user preferences in an audio library collection and then applied during subsequent viewing of the shopping channel, col. 6, lines 40-43 et seq.).

24. Regarding claim 2, **Bahn** additionally teaches a system further comprising storage means arranged to store meta-data comprising information pertaining to said associated first and second content (see disclosure that the storage device may store, *inter alia*, a variety of audio content which can be arranged by style of music, individual song, album, artist, or by other classifications, col. 6, lines 1-7; see also disclosure that the user may upload audio and/or video content, col. 7, lines 15-51).

25. Regarding claim 3, **Bahn** additionally teaches a system further comprising selection means arranged to select the content (see disclosure that the user may choose the audio content to be rendered, col. 2, lines 31-33 et seq.).

26. Regarding claim 4, **Bahn** additionally teaches a system wherein said selection means are further arranged to identify the first content upon selection of the associated second content and/or to identify the second content upon selection of the associated first content (see disclosure that after changing the default audio settings while viewing a shopping channel, the user's selections can be stored as user preferences in an audio library collection and then applied during subsequent viewing of the shopping channel, col. 6, lines 19-51 et seq.).

27. Regarding claim 6, **Bahn** additionally teaches a system further comprising output means arranged to simultaneously output said associated first and second content (see disclosure that the system allows the simultaneous rendering of jazz style music while the user views content on a shopping channel, col. 2, lines 33-36).

28. Regarding claim 7, **Bahn** additionally teaches a system wherein said selection means are further arranged to user-operably modify said meta-data (see disclosure that

the user may upload audio and/or video content, col. 7, lines 15-51; see also disclosure that the system performs explicit profiling, col. 7, lines 52-67).

29. Regarding claim 8, **Bahn** additionally teaches a system wherein said identifying means is arranged to identify a user's usage of a third content of a second or other type, said usage being concurrent to said user's usage of the first content, and said third content being unrelated with the first content, and wherein said associating means is arranged to associate said third and first content (see disclosure of the association of additional content or a variety of different types, col. 3, lines 3-14), the system further comprising rating means arranged to rate said association of the first content with the second content and/or with the third content (see disclosure of both explicit and implicit profiling of the user, col. 7, line 52 through col. 8, line 15).

30. Regarding claim 9, **Bahn** additionally teaches a system comprising a plurality of devices, each device including output means arranged to output at least one type of the media content, and/or input means arranged to obtain at least one type of the media content (see disclosure of a variety of devices, col. 5, lines 4-31 et seq.).

31. Regarding claim 10, **Bahn** additionally teaches a system wherein said first and second content correspond to video and audio content (see disclosure that the system allows a user to customize audio content on interactive television, col. 2, lines 8-10 et seq.).

32. Regarding claim 12, **Bahn** additionally teaches a computer-readable medium containing a computer program product enabling a programmable device, when executing said computer program product, to perform the method as claimed in claim 11 (see disclosure of the use of software, col. 4, line 57 through col. 5, line 3).

33. Claims 1, 3 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by **Ichino** (U.S. Patent 5,440,351).

34. Regarding claim 1, **Ichino** teaches a system for operating with different types of media content as claimed, the system being arranged to enable a user to use a first content of a first type (see disclosure that the system allows a user to render audio

content from a specific radio station concurrently with television content, col. 7, lines 49-53 et seq.), characterized in that the system comprises:

- a) identifying means for identifying that the user concurrently uses a second content of a second type (see disclosure that the system allows a user to select the radio frequency to be rendered with television content, col. 8, lines 20-24 et seq.), said second content being unrelated with the first content (see disclosure that the system allows a user to select *any* radio frequency to be rendered with television content, col. 3, lines 31-35 et seq.);
and
- b) associating means for associating said second content with the first content (see disclosure that the system includes programmable memory with the capability to store a single television channel AM radio frequency association or a number of such associations, col. 8, lines 2-5 et seq.).

35. Regarding claim 11, **Ichino** teaches a method of operating with different types of media content, the method comprising the step of identifying a user's usage of a first content of a first type (see disclosure that the system allows a user to render audio content from a specific radio station concurrently with television content, col. 7, lines

49-53 et seq.), characterized in that the method further comprises a step of identifying that the user concurrently uses a second content of a second type (see disclosure that the system allows a user to select the radio frequency to be rendered with television content, col. 8, lines 20-24 et seq.), said second content being unrelated with the first content (see disclosure that the system allows a user to select *any* radio frequency to be rendered with television content, col. 3, lines 31-35 et seq.), and a step of associating said second content with the first content (see disclosure that the system includes programmable memory with the capability to store a single television channel AM radio frequency association or a number of such associations, col. 8, lines 2-5 et seq.).

36. Regarding claim 3, **Ichino** additionally teaches a system further comprising selection means arranged to select the content (see disclosure that the user may select the frequency of the AM tuner, col. 8, lines 20-24 et seq.).

37. Regarding claim 8, **Ichino** additionally teaches a system wherein said identifying means is arranged to identify a user's usage of a third content of a second or other type, said usage being concurrent to said user's usage of the first content, and said third content being unrelated with the first content, and wherein said associating means is arranged to associate said third and first content (see disclosure of the association of

duplicate television channel/radio frequency associations, col. 10, lines 17-25), the system further comprising rating means arranged to rate said association of the first content with the second content and/or with the third content (see disclosure of the explicit selection of secondary audio content by radio frequency, thus rating the association positively, col. 8, lines 20-24 et seq.).

38. Regarding claim 9, **Ichino** additionally teaches a system comprising a plurality of devices, each device including output means arranged to output at least one type of the media content, and/or input means arranged to obtain at least one type of the media content (see disclosure of both a television and a radio tuner, col. 5, lines 40-66 et seq.).

39. Regarding claim 10, **Ichino** additionally teaches a system wherein said first and second content correspond to video and audio content (see disclosure that the system allows a user to render audio content from a specific radio station concurrently with television content, col. 7, lines 49-53 et seq.).

40. Regarding claim 12, **Ichino** additionally teaches a computer-readable medium containing a computer program product enabling a programmable device, when executing said computer program product, to perform the method as claimed in claim

11 (see disclosure of the remote control device which can be programmed with AM tuner frequency/television channel associations, col. 6, lines 36-68 et seq.).

Claim Rejections - 35 USC § 103

41. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

42. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

43. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

44. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Billmaier** (U.S. Patent 6,630,963) as applied to claims 1-3 and 7-12 above, and further in view of **Bahn** (U.S. Patent 7,162,728).

45. Regarding claim 4, **Billmaier** teaches a system for operating with different types of media content substantially as claimed.

Billmaier does not explicitly teach a system wherein said selection means are further arranged to identify the first content upon selection of the associated second content and/or to identify the second content upon selection of the associated first content.

Bahn, however, teaches a system wherein said selection means are further arranged to identify the first content upon selection of the associated second content and/or to identify the second content upon selection of the associated first content (see disclosure that after changing the default audio settings while viewing a shopping channel, the user's selections can be stored as user preferences in an audio library collection and then applied during subsequent viewing of the shopping channel, col. 6, lines 19-51 et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to register a user's preferences for which media to be played concurrently with another media, and to apply said preferences to subsequent content rendering, since this would save the user the need to repeatedly select their preferred media every time content is being rendered.

46. Regarding claim 6, **Billmaier** additionally teaches a system further comprising output means arranged to simultaneously output said associated first and second content (see disclosure that the system allows the simultaneous rendering of different

content received from different sources, col. 2, lines 44-57; see also col. 6, line 63 through col. 7, line 3).

47. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Billmaier** (U.S. Patent 6,630,963) in view of **Bahn** (U.S. Patent 7,162,728) as applied to claims 4 and 6 above, and further in view of **Kotz et al.** (U.S. Patent Application Publication 20040068552).

48. Regarding claim 5, **Billmaier** and **Bahn** teach a system for operating with different types of media content substantially as claimed.

Neither **Billmaier** nor **Bahn** explicitly teaches a system wherein said selection means are further arranged to function as a recommender for recommending the associated first or second content upon a user-operable selection of one of said associated second and first content, respectively, using said selection means.

Kotz et al., however, teaches a system wherein said selection means are further arranged to function as a recommender for recommending the associated first or second content upon a user-operable selection of one of said associated second and first content, respectively, using said selection means (see disclosure that the system provides recommendations to a user based upon the user's preferences, past selections and user location, paragraph [0010] et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the user the ability to choose from a list of recommended content, since this would give the user the ability to choose from among a variety of content that has been judged to be of potential interest to the user based on their profile and past selections, thus providing access to content that the user might not have chosen explicitly, perhaps because they were not aware of the content, but would be of interest to the user.

49. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bahn** (U.S. Patent 7,162,728) as applied to claims 1-4 and 6-12 above, and further in view of **Kotz et al.** (U.S. Patent Application Publication 20040068552).

50. Regarding claim 5, **Bahn** teaches a system for operating with different types of media content substantially as claimed.

Bahn does not explicitly teach a system wherein said selection means are further arranged to function as a recommender for recommending the associated first or second content upon a user-operable selection of one of said associated second and first content, respectively, using said selection means.

Kotz et al., however, teaches a system wherein said selection means are further arranged to function as a recommender for recommending the associated first or second content upon a user-operable selection of one of said associated second and first content, respectively, using said selection means (see disclosure that the system provides recommendations to a user based upon the user's preferences, past selections and user location, paragraph [0010] et seq.).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the user the ability to choose from a list of recommended content,

since this would give the user the ability to choose from among a variety of content that has been judged to be of potential interest to the user based on their profile and past selections, thus providing access to content that the user might not have chosen explicitly, perhaps because they were not aware of the content, but would be of interest to the user.

51. Claims 2 and 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Ichino** (U.S. Patent 5,440,351) as applied to claims 1, 3 and 8-12 above, and further in view of **Minh** (U.S. Patent 6,195,707).

52. Regarding claims 2 and 7, **Ichino** teaches a system for operating with different types of media content substantially as claimed.

Ichino does not explicitly teach a system further comprising storage means arranged to store user-modifiable meta-data comprising information pertaining to said associated first and second content.

Minh, however, teaches a system further comprising storage means arranged to store user-modifiable meta-data comprising information pertaining to said associated first and second content (see disclosure that the system maintains an alias file to associate user-defined alias's with the URL of a web page, col. 1, line 64 through col. 2, line 24 et seq.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the alias mechanism disclosed by **Minh** with the radio frequency selection apparatus disclosed by **Ichino**, since this would allow a user to assign a familiar customized label to a given radio station, alleviating the need to memorize the frequencies of all desired radio stations.

53. Regarding claim 4, **Ichino** additionally teaches a system wherein said selection means are further arranged to identify the first content upon selection of the associated second content and/or to identify the second content upon selection of the associated first content (see disclosure that when the TV/Radio button is pressed, the system searches memory to see if it contains an entry for a television channel corresponding to the currently-active channel, and if so, sets the AM radio tuner to the associated radio frequency, col. 9, lines 7-20).

54. Regarding claim 5, **Ichino** additionally teaches a system wherein said selection means are further arranged to function as a recommender for recommending the associated first or second content upon a user-operable selection of one of said associated second and first content, respectively, using said selection means (see disclosure that duplicate associations between radio frequencies and television channels may be stored, and the viewer would be allowed to scroll through the associations in order to select the desired frequency, col. 10, lines 17-25).

55. Regarding claim 6, **Ichino** additionally teaches a system further comprising output means arranged to simultaneously output said associated first and second content (see disclosure that the selected AM radio broadcast is reproduced through the television sound system, col. 9, lines 14-20).

Response to Arguments

56. Applicant's arguments filed 29 July 2008 have been fully considered but they are not persuasive.

57. Regarding the Applicants' argument that the amendment to claim 12 resolves the pending claim objection, the examiner respectfully disagrees.

Under the terms of the Infringement Test, the test for a proper dependent claim is that the dependent claim "shall not conceivably be infringed by anything which would not also infringe the basic claim." See MPEP § 608.01(n)III.

As discussed *supra*, claim 12 could be infringed by, *inter alia*, a CD-ROM storing a software program. However, until said CD-ROM were inserted into a computer, and the software stored thereon read into memory and executed, parent method claim 11 is not infringed.

Therefore, claim 12 fails the Infringement Test, and is objected to accordingly.

58. Regarding the Applicants' argument that claims 1, 3, 8 and 10 recite statutory subject matter under 35 U.S.C. § 101, the examiner respectfully disagrees.

As pointed out by the Applicants in their remarks on page 6, the claimed invention may relate to a computer program executable on a computer, but is not limited to a software implementation.

In order for a claim to qualify as statutory subject matter, the scope of the claim must be limited only to statutory embodiments. This means that so long as the scope of

the claim is broad enough to include non-statutory (in this case, software-only) embodiments, the claim as a whole is rendered non-statutory.

In order to comply with the requirements for statutory subject matter under 35 U.S.C. § 101, the claims must be amended to specifically exclude non-statutory (software-only) embodiments. One way in which to comply with this requirement would be to include in the claims at least one component of the hardware environment which is required in order to execute the software and thus enable the functionality embodied therein to be realized (such as by the incorporation of the subject matter of dependent claim 2 into independent claim 1).

59. Regarding the Applicants' argument that the **Billmaier** reference fails to disclose the claimed means for identifying that the user concurrently uses a second content of a second type, the examiner respectfully disagrees.

The **Billmaier** reference discloses the selection by the user of a secondary audio program. The system responds by replacing the primary audio program with the secondary audio program, which clearly discloses that there is a means for identifying that the user concurrently uses a second content of a second type. The system itself replaces the primary audio program with the secondary audio program, and so clearly identifies that the user is concurrently using a secondary audio content of a second

audio type, since it is the mechanism through which the secondary audio program is rendered to said user.

The Applicants further argue that "...there is nothing in **Billmaier** that would enable the system therein to identify how a user behaves when a particular first content is used". The examiner points out that for the purposes of anticipating the limitations present in the claims, the fact that the system disclosed in the **Billmaier** reference can discern the user's request to switch to a secondary audio program constitutes the claimed identifying means.

60. Regarding the Applicants' argument that the **Bahn** reference also fails to disclose the identifying means, the examiner likewise respectfully disagrees.

As above, the **Bahn** reference discloses a mechanism wherein the user can request a customized (secondary) audio content in coordination with video content. The components of **Bahn's** system which discern the user's request to render said customized (secondary) audio content clearly constitutes the claimed identification means for identifying that a user concurrently uses a second content of a second type, since the system itself is performing the rendering of the secondary audio content, and so certainly has identified that the user is using said secondary audio content.

61. The Applicants' argument regarding the **Ichino** reference is analogous to that of the **Billmaier** and **Bahn** references, and is respectfully disagreed with for the same reasons cited above.

62. To the extent that the Applicants argument that the **Kotz et al.** and **Minh** references fail to disclose the claimed identifying means, the examiner responds that this argument is moot, since these references are not relied upon to teach this limitation.

63. In response to the Applicants' argument that the **Minh** reference fails to disclose the claimed storage of meta-data comprising information pertaining to said associated first and second content, the examiner respectfully disagrees.

The **Ichino** reference discloses the ability to render video (television) content from one source and audio (radio) content from another source. The **Minh** reference teaches the storage of URLs with an alias, which in light of the myriad sources on the Internet for streaming video and audio content, constitute the claimed meta-data comprising information pertaining to associated with a first and second content.

64. The rejections of record are maintained.

Conclusion

65. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119, or sent via email at luke.wassum@uspto.gov, **with a previous written authorization in accordance with the provisions of MPEP § 502.03.** Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, reading "Luke S. Wassum". The signature is fluid and cursive, with a long horizontal stroke at the end.

/Luke S. Wassum/
Primary Examiner
Art Unit 2167

lsw
4 October 2008